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**AMENDMENT / RESPONSE TRANSMITTAL**

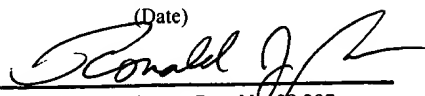
Applicants : Jacobi, et al.  
App. No : 09/933,277  
Filed : August 20, 2001  
For : SERVICES FOR INCREASING THE  
UTILITY OF ELECTRONIC WISH  
LISTS  
Examiner : Ronald Laneau  
Art Unit : 3627

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence and all marked attachments are being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on

February 18, 2005

(Date)

  
Ronald J. Schoenbaum, Reg. No. 38,297

**Mail Stop Amendment**

Commissioner for Patents

P.O. Box 1450

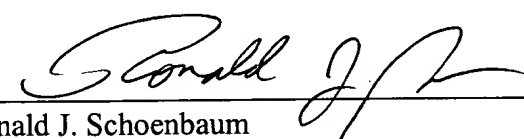
Alexandria, VA 22313-1450

Sir:

Transmitted herewith for filing in the above-identified application are the following enclosures:

- (X) Response to Office Action, Substance of Telephone Interview, and Response to Restriction Requirement in 6 pages; and
- (X) A return prepaid postcard.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

  
Ronald J. Schoenbaum  
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Customer No. 20,995  
(949) 760-0404



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants	:	Jacobi, et. al.	)	Group Art Unit: 3627
			)	
Appl. No.	:	09/933,277	)	
			)	
Filed	:	August 20, 2001	)	
			)	
For	:	SERVICES FOR INCREASING	)	
		THE UTILITY OF	)	
		ELECTRONIC WISH LISTS	)	
			)	
Examiner	:	Ronald Laneau	)	
			)	

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RESPONSE TO OFFICE ACTION,  
SUBSTANCE OF TELEPHONE INTERVIEW, AND  
RESPONSE TO RESTRICTION REQUIREMENT

Commissioner of Patents and Trademarks  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This communication is responsive to the Office Action mailed on November 26, 2004, and to the restriction requirement set forth in the Interview Summary mailed on February 8, 2005. Please reconsider the above-referenced application in view of the following remarks.

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### REMARKS

In the Office Action mailed on November 26, 2004 (hereinafter "the Office Action"), the Examiner rejected all of the pending claims on obviousness grounds over Knorr et al. (US 2002/0077929) in view of Covington et al. (US 2003/0154135 A1) and further in view of Westrope et al. (US 5,721,832). These three references will be referred to herein collectively as "the applied references."

Initially, Applicants' representative would like to thank Examiner Laneau for the courtesy he extended during the telephone interview conducted on February 4, 2005.

#### I. Substance of Interview

During the telephone interview, Applicants' representative pointed out that Covington et al. was filed after the present application, and that at least some of Covington et al.'s disclosure relied on to reject Applicants' claims is not disclosed in the earlier application (no. 09/705,252) of which Covington et al. is a continuation-in-part.

In addition, Applicants' representative asserted that even if the entire disclosure of Covington et al. were treated as prior art, the rejection would still be improper because, among other reasons, the applied references do not individually or collectively disclose or suggest all of the limitations of any pending independent claim. Applicants' representative identified the following excerpt of Claim 1 as providing one example of limitations that are not disclosed or suggested by the applied references: "a notification component which is responsive, to an online request from a first user for a catalog page which includes a description of a first item, by at least (a) determining whether the first item is on an electronic wish list of a user who is affiliated with the first user, and (b) when the first item is determined to be on an electronic wish list of a second user who is affiliated with the first user, supplementing the page with a notification that the first item is on the wish list of the second user."

The Examiner indicated that he could not respond to the foregoing arguments without reviewing Covington et al. in further detail. In addition, the Examiner asserted that the

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pending claims are directed to multiple distinct inventions, and indicated that he would impose a restriction requirement via the Interview Summary.

Claim 1 was the primary claim discussed during the interview, although the other independent claims were also very briefly discussed. Covington et al. was the only reference specifically discussed. No exhibits or demonstrations were presented, and no amendments were proposed.

## **II. Response to Restriction Requirement**

In response to the restriction requirement set forth in the Interview Summary mailed on February 8, 2005, Applicants hereby elect Claims 1-35 (group one), without traverse.

## **III. Discussion of Art-Based Rejection of Claims 1-35**

Applicants respectfully submit that the rejection of Claims 1-35 is improper for at least the following reasons, each of which is discussed separately below: (1) at least some of the subject matter disclosed in Covington et al. and relied on by the Examiner is not "prior art," (2) the applied references do not disclose or suggest all of the limitations of any independent claim, and (3) the Examiner has not identified a suggestion or motivation to combine Knorr et al. and Covington et al.

- 1. The rejection of Claims 1-35 is improper because at least some of the subject matter disclosed in Covington et al. and relied on by the Examiner is not "prior art."**

As discussed during the telephone interview, Covington et al. was filed after the present application, and is a continuation-in-part of U.S. Appl. No. 09/705,252 (hereinafter "the Covington et al. parent"), which as filed prior to the present application. Pursuant to M.P.E.P. § 706.02(f)(1), the "102(e) date of a reference ... is its earliest effective U.S. filing date, taking into consideration any proper benefit claims to prior U.S. applications ... *if the prior application(s) properly support the subject matter used to make the rejection*" (emphasis added). Thus, subject matter which is disclosed only in Covington et al., and not

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in the Covington et al. parent, cannot be "prior art" under 35 U.S.C. § 102(e) to the present application.<sup>1</sup>

In rejecting the claims of the present application, the Examiner relied on subject matter that is disclosed only in Covington et al., and not in the Covington et al. parent. For example, in the Office Action, the Examiner relied on Covington et al.'s disclosure, at paragraph 12, lines 11-16, of the ability for a user who is creating a wish list to select, from an address book, one or more buyers to be notified of the wish list. Office Action at page 4, lines 1-6. The Covington et al. parent does not, however, disclose any such use of an address book. The rejection is therefore improper.

**2. The rejection of Claims 1-35 is improper because the applied references do not disclose or suggest all of the limitations of any independent claim.**

Even if the entire disclosure of Covington et al. is treated as prior art, the obviousness rejection is still improper because, among other reasons, the applied references do not disclose or suggest all of the limitations of independent Claim 1, independent Claim 12, independent Claim 24, or independent Claim 33. With respect to Claim 1, for example, the applied references do not disclose or suggest "a notification component which is responsive, to an online request from a first user for a catalog page which includes a description of a first item, by at least (a) determining whether the first item is on an electronic wish list of a user who is affiliated with the first user, and (b) when the first item is determined to be on an electronic wish list of a second user who is affiliated with the first user, supplementing the page with a notification that the first item is on the wish list of the second user," within the context of the other claim limitations.

With respect to independent Claim 12, the applied references do not disclose or suggest "monitoring browsing of the electronic catalog by the first user to determine whether items accessed by the first user are on electronic wish lists of the affiliated users; and notifying the first user during said browsing of the electronic catalog when an accessed item is determined to be on an electronic wish list of an affiliated user," in the context of the other claim limitations.

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<sup>1</sup> This is true regardless of whether the provisional application referenced in Covington et al. discloses such subject matter. See M.P.E.P. § 2127, subsection I.

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With respect to independent Claim 24, the applied references do not disclose or suggest "in response to a second user purchasing an item from the electronic wish list of the first user, updating a data repository to indicate that the first user is affiliated with the second user; and subsequently to updating the data repository, monitoring browsing of the electronic catalog by the second user and, during said browsing of the electronic catalog, notifying the second user when an item accessed by the second user is on the electronic wish list of the first user," in the context of the other claim limitations.

With respect to independent Claim 33, the applied references do not disclose or suggest "when the first user accesses a first item in the electronic catalog, determining whether, and notifying the first user if, the first item is similar to an item on an electronic wish list of an affiliated user, as reflected by the similarity data," in the context of the other claim limitations.

The foregoing are merely examples of claim limitations that are not disclosed or suggested by the applied references. Other distinguishing limitations are recited in both the independent and the dependent claims.

**3. The rejection of Claims 1-35 is improper because the Examiner has not identified a motivation or suggestion to combine Knorr et al. with Covington et al.**

Applicants also respectfully submit that the rejection of Claims 1-35 is improper because the Examiner has not identified a suggestion or motivation to combine the teachings of Knorr et al. and Covington et al. In connection with this issue, the Examiner asserts that it would have been obvious to combine these two references because the combination "would provide a system that allows buyers to easily shop for others by searching for a user's wish list and personal preferences at the system Web site and allow the user to select one or more buyers from an address book and notify the selected buyers of a specific wish list via e-mail." Office Action at page 4, lines 1-6. This assertion, however, appears to be nothing more than a statement of what is disclosed at paragraph 12, lines 11-16 of Covington et al. As such, it is not a suggestion or motivation to combine the teachings of Knorr et al. and Covington et al.

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IV. Conclusion

In view of the foregoing remarks, Applicants submit that Claims 1-35 (elected herein) are patentably distinct from the applied references, and request that the obviousness rejection of these claims be withdrawn.

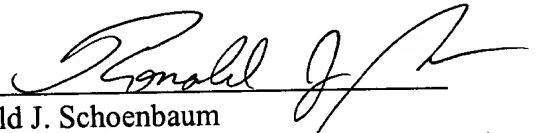
Applicants reserve the right to swear behind one or more of the applied references in response to a subsequent Office Action.

If any issues remain in the present application, the Examiner is requested to call the undersigned representative at his direct dial number of 949-721-2950.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 2-18-05

By:   
Ronald J. Schoenbaum  
Registration No. 38,297  
Attorney of Record  
Customer Number 20,995

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